

Remarks

In response to the Notice of Non-Compliant amendment mailed September 9, 2009, Applicants respectfully request the Examiner to enter the amendment as revised and reconsider and reexamine the application as amended.

Format of Claim Amendments

Applicants have included only those claims being changed or added by this paper with markings relative to the patent as required by 37 CFR §1.173(b). Applicants believe the amendment now complies with the rule and request favorable consideration and entry.

Reissue Oath/Declaration

The Examiner indicated that when an amendment is filed that places the reissue application in condition for allowance, a supplemental oath/declaration will be required. Applicants note that MPEP §1444(II) states "Once the reissue oath/declaration is found to comply with 37 CFR 1.175(a), it is not required, nor is it suggested, that a new reissue oath/declaration be submitted together with each new amendment and correction of error in the patent. During the prosecution of a reissue application, amendments are

often made and additional errors in the patent are corrected. A supplemental oath/declaration need not be submitted with each amendment and additional correction. Rather, it is suggested that the reissue applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to 37 CFR 1.175(b)(1)." As such, Applicants respectfully request the Examiner to consider this amendment and hold in abeyance any requirement for an additional supplemental oath/declaration until the application is indicated to be in condition for allowance.

Surrender and Recapture

In the outstanding office action, claims 1, 7, 8, 10-12, 66, 84-120 were presented for examination. Claims 84 -120 are new to the reissue application. The examiner rejected the claims, which were previously allowed, after a second pair of eyes review in the United States Patent and Trademark Office raised the issue of surrender and recapture.

Applicants respectfully disagree and traverse the rejection. As part of the recapture analysis stated in *In re Clement*, "The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered

particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort **to overcome a prior art rejection**. See Mentor, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; Ball Corp. v. United States, 729 F.2d 1429, 1436, 221 USPQ 289, 294-95 (Fed.Cir.1984)” (emphasis added). Likewise, the Examiner’s attention is drawn to MPEP §1412.02 I(B)(1), which states “If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application **to make the claims allowable over the art**, the omitted limitation relates to subject matter previously surrendered by applicant” (emphasis added). See also the flow chart in MPEP §1412.06(VI).

In this case, the amendment made during prosecution was made to overcome a rejection under 35 USC §112, not to overcome a prior art rejection. Applicants stated in the response to the rejection that the claims were amended “to more particularly define the invention.” (p. 9, Reply under 37 CFR 1.116 filed June 11, 1999). Even if Applicants amendment was made to distinguish over the prior art, which it was not, “Deliberately canceling or amending a claim **in an effort to overcome a reference** strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable, **but it is not dispositive because other evidence in the prosecution history may indicate the contrary.**[2] See Mentor, 998 F.2d

at 995-96, 27 USPQ2d at 1524-25; Ball, 729 F.2d at 1438, 221 USPQ at 296; Seattle Box Co., 731 F.2d at 826, 221 USPQ at 574 (declining to apply the recapture rule in the absence of evidence that the applicant's "amendment ... was in any sense an admission that the scope of [the] claim was not patentable") *In re Clement*. In the instant application, because the amendment was not made in response to a prior art rejection, and the prosecution history clearly indicates that the amendment was made to more particularly define the invention, there was no surrender of this subject matter by Applicants. Therefore, there is no recapture by modifying or removing this limitation.

However, if the Examiner maintains that even an amendment that was not made to overcome a prior art rejection gives rise to surrender, the language at issue, "maximizes throughput and minimizes astigmatism," is substantially included in independent claims 111, 112, 117, and 128, and these claims thus clearly do not involve any possible question of surrender and recapture. As such, Applicants respectfully request the Examiner to reconsider and withdraw the rejection based on recapture at least with respect to these claims.

In addition, the remaining independent claims all recite language which was not at issue during the original prosecution of the issued patent in the amendment and/or argument that resulted in allowance.

Rather, the remaining independent claims include limitations unrelated thereto, and, accordingly, render application of the surrender and recapture doctrine inappropriate.

While a number of amendments have been made to improve the form of the claims, it is believed that the subject matter of the claims as amended was never surrendered during the original prosecution and is therefore not being recaptured by these claims as previously allowed by the Examiner. As such, Applicants respectfully request the Examiner to reconsider and withdraw the rejection based on recapture.

Dependent claims 7, 8, 10, 11, 12, 84-104 and 121-124 all ultimately depend from claim 1 and limit that claim. Accordingly, they are in condition for allowance. Moreover, they limit claim 1 in significant ways which are different from the amendment which resulted in allowance. Accordingly, for this reason alone they are believed to clearly not involve recapture.

Claim 66 recites receiving a nonzero order of diffracted light without significant mixing with adjacent orders of diffracted light. This limitation is unrelated to the limitation argued in order to obtain allowance of the original patent application. Accordingly, no recapture is involved, and the claim is presently in condition for allowance.

Claim 105, in addition to being allowable as being dependent on claim 66 and further limiting it, is also allowable in so far as it recites significant limitations to claim 66 which are different from those at issue in the amendment which resulted in allowance of the original application. Accordingly, there is no recapture and claim 105 is in condition for allowance.

While Claim 106 does not have language with respect to minimization of astigmatism and maximization of throughput, neither does originally allowed method claim 67 of the original application. Both of these claims are drawn to a method in accordance with the invention having two entrance ports and two exit ports. Accordingly, there is no question of surrender and recapture. Generally, this claim has been changed largely to address formal issues. Clearly, given the scope of original claim 67, it is believed that claim 106 should be allowed as it does not involve any question of surrender and recapture.

Claims 107-110 limit claim 106 and are thus also clearly in condition for allowance. Moreover, they recite significant limitations not at issue in the amendment which resulted in the allowance of the underlying original patent and, accordingly, for this reason also are not correctly rejected under the surrender and recapture doctrine.

The language at issue, "maximizes throughput and minimizes astigmatism," is substantially included in independent claims 111, 112, 117, and 128 as noted above, and these claims thus clearly do not involve any possible question of surrender and recapture. Allowance of the same is respectfully sought. Claims 113-116 depend from claim 112, further limit that claim and are, accordingly, allowable. Moreover, such limitations relate to features of the invention which were not at issue in the amendment which resulted in allowance of the original application and, accordingly, for this reason alone are also believed to be clearly not subject to the surrender and recapture rule.

In similar fashion, claims 118-120 depend from claim 117 and further limit that claim in a way which makes them also most clearly not subject to the surrender and recapture rule.

Claim 129 contains limitations that the exit port and the entrance port are on opposite sides of a second plane which is both perpendicular to the meridian plane and passes through the optical axis of the grating. This limitation relates to features of the invention which were not at issue in the amendment which resulted in allowance of the original application and, accordingly, this claim 129 is clearly not subject to the surrender and recapture rule.

Summary

For the reasons above, Applicants respectfully submit that there was no surrender of subject matter during the original prosecution as the amendments were made in response to a rejection under 35 USC §112 and were not in response to a prior art rejection. Furthermore, a number of claims include limitations that are commensurate in scope, or include additional limitations, so that there can be no recapture.

The Examiner is invited to contact the undersigned at the telephone number indicated below to discuss resolution of any remaining issues to place this application in condition for allowance.

The fee for a 2-month extension of time has been paid upon filing. No additional fees are believed to be due as a result of filing this paper. However, please charge any additional fees required or credit any overpayment to Deposit Account No. 02-3978.

Respectfully submitted,

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